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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,316	05/26/2000	Pierre Girard	100954-001	9687

7590

12/23/2002

Thomas J. Wall, Esq.
Wall, Marjama & Bilinski
101 South Salina Street
Suite 400
Syracuse, NY 13202

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 12/23/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/508,316

Applicant(s)

GIRARD ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed October 8, 2002.

Claims 1 and 4 were amended rendering claims 1-8 pending.

Claim Rejections – 35 USC § 102(b)

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (U.S. 4,298,652).
4. Suzuki discloses a method of producing coated paper for gravure printing, where the paper is fiber based and the coating comprises pigments containing calcium carbonate (abstract and column 2, lines 35-42) where the paper consists of a double coating (abstract). Suzuki teaches calendering the paper (column 1, line 68). Suzuki discloses a coating composition using a size press in the paper making process (column 4, lines 12-19) and the base paper is multiple-coated by means of a coater with

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a coating weight above 2 g/m² (column 7, lines 26-31). Suzuki discloses a coating composition comprising a pigment comprising {precipitated calcium carbonate} (column 5, lines 30-40). The reference discloses the coating composition forming each layer in multiple coating may be changed suitably and may be done by any process and by means of any conventional coating machines (column 7, lines 33-36). Suzuki discloses dry coating weight (column 8, line 42) and pigment in the coating (column 11, lines 31-32).

Claim Rejections – 35 USC § 103(a)

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. 4,298,652) in view of Li (U.S. 6,183,844).

7. Suzuki is relied upon for claims 1, 3-7. Suzuki does not disclose the interior coating consisting of silica. Li teaches a printing medium suitable for inkjet printing comprising a substrate having at least two coatings applied sequentially (abstract) where the interior coating may be comprised with the same materials or different materials from the exterior coating (column 13, lines 41-44) consisting of particles (column 14, lines 6-9). Li teaches these particles consist of silica and other particles

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(column 14, lines 39) and colloidal silica (column 15, line 14). Although Li does not teach gravure or flexographic printing, Applicant claims "a paper and a board consisting of a fibrous medium coated with at least one conventional surface coat *intended* to be printed by gravure or flexographic printing." Although the invention may be *intended* to be printed by gravure or flexographic printing, the invention is based on a coated paper and not what the coated paper is intended to be printed with. This limitation of the claim(s) offers no positive level of criticality to the coated paper, absent any showing of unexpected results.

Suzuki and Li are analogous art because they are from the same field of printing mediums. It would have been obvious to one of ordinary skill in the art to include the interior coating of Suzuki consisting of silica because Li teaches coated interior layers of printing mediums are known in the art and soften the coated material to make it more flexible.

8. Nakanishi et al. (U.S. 6,280,830) is cited as being relevant to pointing out analogous components of pigments.

Response to Arguments

9. Applicant's arguments of rejection under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. 4,298,652) in view of Li (U.S. 6,183,844) have been considered and are rendered moot based on grounds of new rejection.

Applicant's arguments of rejection under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. 4,298,652) have been considered but are unpersuasive. Applicant argues Li does not refer to gravure or flexographic printing, but instead relates to inkjet printing process. Applicant claims "a paper and a board consisting of a fibrous medium coated with at least one conventional surface coat *intended* to be printed by gravure or flexographic printing." Although the invention may be *intended* to be printed by gravure or flexographic printing, the invention is based on a coated paper and not what the coated paper is intended to be printed with. This limitation of the claim(s) offers no positive level of criticality to the coated paper and is given little patentable weight. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Applicant argues the intended use of the combined references are different so one of ordinary skill in the art would not have combined Suzuki et al and Li. The intended use of Suzuki and Li are of little consequence; however, because they are from the same field of printing mediums. It would have been obvious to one of ordinary skill in the art to include the interior coating of Suzuki consisting of silica because Li teaches coated interior layers of printing mediums are known in the art and soften the coated material to make it more flexible.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM

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– 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for

After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)

308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

